

In re Patent Application of  
Zacco  
Serial No. 10/657,327  
Filed September 8, 2003

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### **REMARKS**

Applicant appreciates the Examiner's careful review of the application and provides the remarks set out below in response to the Examiner's concerns expressed in the pending Office action. A terminal disclaimer is enclosed.

### **Election of Claims**

Applicant has affirmed the election previously discussed with the Examiner by telephone. Having elected claims in Group I, the non-elected claims have been withdrawn.

### **The Claims Are Novel Over The Cited References**

The Examiner has rejected independent claims 9 and 17 as anticipated under Section 102(b) by the reference to Williams (US Patent 5,636,379). The Examiner takes the position that Williams describes a substantially rigid, protective mold being the remaining portion of the body, posterior components bilaterally, col. 6, lines 20-21 and col. 3, lines 17-21. Applicant has carefully reviewed the Williams reference and respectfully disagrees for the following reasons.

In the present application, claim 9 recites "a substantially rigid, *protective mold of a thermostable material*, said protective mold forming a portion of said mouthpiece body so that the mold protects at least a periphery of the mouthpiece body." The claim language has been clarified to indicate that this "protection" refers to preventing the person's teeth from imprinting on the mouthpiece where the protective mold is positioned. This is explained in the application as filed, on page 2, lines 13-15 and 23-25.

The recitation in claim 17 is substantially the same and does not require clarification, particularly since this claim recites a method that includes "imprinting the person's teeth along a surface of the mouthpiece body not protected by the mold by biting down on the mouthpiece."

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The Williams reference, on the other hand, teaches that those parts of the device "in direct contact with the tooth surfaces is made of thermoplastic material that softens when heated above body temperature and rigidly stiffens when cooled." Accordingly, Williams does not describe the mouthpiece device recited in present claims 9 and 17 and cannot, therefore, anticipate those claims. Williams, in fact, differs and teaches away from the presently claimed mouthpiece device. For those reasons, Applicant respectfully requests that the Examiner withdraw the anticipation rejections of claims 9 and 17.

#### **The Pending Claims Are Nonobvious In View Of The Cited References**

The Examiner has also rejected independent claim 18 as obvious in view of the combined references of Williams, Shapiro (US Patent 5,117,816) and Sue (US Patent 6,295,988). For the following reasons, Applicant suggests that the cited references do not establish a *prima facie* case of obviousness against claim 18.

As shown above, the Williams reference teaches away from the present invention. Williams teaches a mouthpiece wherein all surfaces which come in contact with the person's teeth are made of a thermoplastic material. In the present invention, however, a substantially rigid protective mold of a thermostable material protects at least a periphery of the mouthpiece from imprinting by teeth. Since the Williams reference teaches away from the present invention and neither Shapiro nor Sue describe a protective thermostable mold, this combination of references does not establish a *prima facie* case of obviousness against the rejected claims. Accordingly, the obviousness rejection should be withdrawn and Applicant respectfully so requests from the Examiner.

#### **Conclusion**

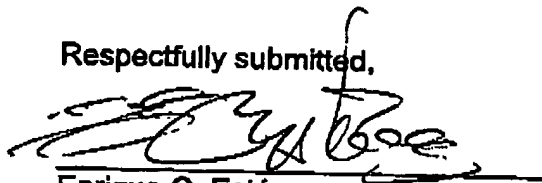
Applicant has shown how the cited references do not establish *prima facie* obviousness of the claims. Additionally, Applicant herewith encloses a terminal disclaimer

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as required by the Examiner, thereby obviating the double patenting rejection. Therefore, Applicant respectfully requests that the Examiner allow the claims and pass the application to issue.

If the further prosecution can be facilitated through a telephone conference between the Examiner and the undersigned, the Examiner is respectfully requested to telephone the undersigned.

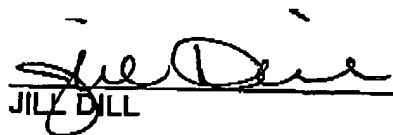
Respectfully submitted,



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**CERTIFICATE OF FILING BY FACSIMILE**

I hereby certify that the foregoing is being filed with the United States Patent and Trademark Office via facsimile to its centralized fax number at 571-273-8300 this 9th day of August, 2005.

  
JILL DILL